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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,907	07/02/2004	Hisashi Tsukamoto	Q121-US4	8890
<div>Travis Dodd Quallion LLC PO Box 923127 Sylmar, CA 91392-3127</div>				
7590 01/09/2008			EXAMINER TSO, EDWARD H	
			ART UNIT 2838	PAPER NUMBER
			MAIL DATE 01/09/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/500,907

Applicant(s)

TSUKAMOTO ET AL.

Examiner

Edward Tso

Art Unit

2838

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/19/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 50-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 50-86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

The indicated allowability of claims 50-86 is withdrawn in view of the newly discovered reference(s) to Hallaj et al. (US 6,468,689). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 50-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hallaj et al. (US 6,468,689). The reference discloses a battery housing 10 with a plurality of batteries 14-28 mounted within the housing. A heat absorbing material 34 is in contact with the batteries and the housing. See figure 1; column 3, line 50 to column 4, line 5.

Regarding claims 50, 51, 62 and 64, the electrodes are an inherent feature of the pack. Otherwise there is no transfer of charge between the pack and the device to be powered. The heat absorbing material exhibits phase change at temperature T1 can be found at column 4, lines 17-30. The material is made of paraffin wax. Column 4, line 28. The reference however does not disclose the environment where the battery is being used. More specifically, it does not disclose the battery being used in an implantable device. It would have been obvious to one having ordinary skill in the art to have included such a battery in an implantable device or any other device where generated heat is a 'threat' since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claims 52-54, 57, 63, 65-70, 73, 78 and 81-85, the reference does not disclose the heat absorbing material being positioned between the battery case and the device housing. It would have been obvious to one having ordinary skill in the art to have 'wrapped' the battery casing with the heat absorbing material because (1) it would

be an easier process to wrap the entire battery housing than individual battery within the housing and (2) rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Regarding claims 55 and 71, the reference does not disclose a second battery mounted within the casing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to place any number of batteries within the casing, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claims 58-61, 74-77, 79, 80 and 86, the reference does not disclose any other type of heat absorbing material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected any appropriate type of heat absorbing material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection. The Terminal Disclaimer has been approved.

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Conclusion

Any inquiry concerning this communication should be directed to the Examiner at the below-listed number on every Tuesday, Thursday and Saturday.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist at (571) 272-2800, Monday-Friday, 8:30am to 5:00pm, EST.

By: /Edward H Tso/

EDWARD H TSO
Primary Examiner
(571) 272-2087